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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,051	10/12/2004	Yukio Nakagawa	1745.1002	6192

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

JOY, DAVID J

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/511,051	Applicant(s) NAKAGAWA ET AL.	
	Examiner David J. Joy	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>04042006</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-12-04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Claims 1-11 in the reply filed on February 15, 2006 is acknowledged.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP03/09447, filed on July 25, 2003.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese patent of Takazono et al. (JP02001055202A). The examiner requested a

spot translation of the Japanese patent of Takazono, and the analysis contained within this office action relies upon that translation as well as the abstract and the drawings. A full written translation has already been ordered.

5. With regard to Claim 1, Takazono teaches in Figures 1 and 2, a wound strip of packaging material (10, the roll of wrapping paper) and a recording medium provided on the wound strip with readably recorded packaging related information thereon (11, pieces of identification which show information).

6. As for Claim 2, Takazono discloses including a packaging condition on the material (Column 3, Paragraph 0009). The Takazono material is such that the identifier possesses rate detection means to detect the reading rate and control the discharge of wrapping paper.

7. In terms of Claim 3, Takazono provides information related to a material of the strip (Column 3, Paragraph 0009). The pieces of identification include the type of a wrapping paper that can be used.

8. As for Claim 4, the material in Takazono includes information related to the fabrication of the strip (Column 3, Paragraph 0009). The pieces of identification show the material of which the strip may be fabricated.

9. With regard to Claim 5, Takazono teaches the inclusion of a packaging material identifier (Column 3, Paragraph 0009). The identity of the packaging material is incorporated into the pieces of information located on the wound strip.

10. In terms of Claim 6, Takazono addresses the inclusion of a product identifier (Column 3, Paragraph 0009). The correlation between the packaging material and the

contents is placed on the identifier, and the presence of a different identifier is capable of being detected as such.

11. As far as Claims 5 and 6 are concerned, the phrases "for identifying said strip of packaging material" and "for identifying said product to be packaged" merely recite the intended use of the identifier. Applicant's present claims do not structurally or materially define anything over that which is taught by Takazono.

12. As for Claim 9, Takazono shows in Figure 7, the wound strip of material having a hollow core (9) and the recording medium (21) being provided near the hollow core.

13. In terms of Claim 10, Takazono provides in Figures 2, 4 and 5, a recording medium (11, 11a, 11b and 11c) at an end of or near an end of the outermost periphery of the wound strip of material.

14. With regard to Claim 11, in Figure 6, Takazono teaches a recording medium provided on a sheet-like member affixed to an end (10a and 10b) of the outermost periphery of the wound strip of material.

15. In Claims 1-6, the recitation of such phrases as "a wound strip of packaging material for use in packaging a product" (from Claim 1) and "wherein said packaging related information includes a packaging condition for packaging the product using said strip of packaging material" (from Claim 2) does not positively recite any definite structure over that which is taught by the Takazono patent. Applicant has simply recited a condition for packing the product, which merely refers to the intended use of the recording medium. Furthermore, applicant has not positively recited a product but only

a “material” that could potentially be used “in packaging a product” which defines nothing structurally distinct over that of the “paper” as taught by Takazono.

16. Claims 1-6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. patent of Sacchetti et al. (6,588,666).

17. With regard to Claim 1, Sacchetti teaches in Figure 2, a wound strip of packaging material (16, a roll of plastic bags) and in Figure 14, a recording medium provided on the wound strip with readably recorded packaging related information thereon (21A, bar code indicia).

18. As for Claim 2, Sacchetti addresses the inclusion of a packaging condition on the strip (Column 3, lines 53-55). The Sacchetti strip is such that the indicia act to determine the stop position and length of the bags to be described.

19. In terms of Claim 3, Sacchetti provides information related to a material of the strip (Column 3, lines 48-50). The bar code indicia can be read so as to indicate the presence of a roll of the bags.

20. As in Claim 4, Sacchetti addresses information related to the fabrication of the strip (Column 3, lines 50-53). The bar code indicia can be used to locate the seal lines, to create the bottom of the bags, and the perforation lines to locate the top end of bags.

21. With regard to Claim 5, Sacchetti teaches the inclusion of a packaging material identifier (Column 3, lines 50-53). The identity of the bags is incorporated into the bar code indicia located on the roll.

22. In terms of Claim 6, Sacchetti addresses the inclusion of a product identifier (Column 3, 48-55). The correlation between the bag and the contents is on the bar code indicia, and the indicia can be read to determine the length of the bag to be described.

23. Upon examination of Claims 2-6, it is clear that the phrases “for packaging the product using said strip of packaging material” (Claim 2), “for identifying said strip of packaging material” (Claim 5) and “for identifying said product to be packaged” (Claim 6) merely recite the intended use of the identifier. Applicant’s present claims do not structurally or materially define anything over that which is taught by Sacchetti.

24. As in Claim 10, Sacchetti provides in Figures 14 and 14A, a recording medium (21A) at an end of or near an end of the outermost periphery of the wound strip of material.

25. In Claims 1-6, the recitation of the phrase “wherein said packing related information includes” and all of the terms that follow those phrases fail to positively recite any definite structure over that which is taught by Sacchetti. Applicant has merely recited a condition for packaging the product, which merely refers to the intended use of the recording medium. Likewise, applicant has not positively recited a product but only a material “for use in packaging a product” which defines nothing that is structurally distinct over that of a roll as taught by Sacchetti.

26. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. patent of Maruhashi et al. (6,817,789).

27. In terms of Claim 1, Maruhashi teaches a wound strip of material (Column 2, Lines 63-64, the material is supplied in a form of a material roll) and a recording medium provided on the wound strip with readably recorded packaging related information thereon (Column 10, Lines 30-37).

28. As for Claim 2, Maruhashi addresses the inclusion of a packaging condition on the material (Column 9, lines 31-35). The information may be read from a bar code sheet and, according to the information type that is read, the relevant sections of the material are conditioned according to the obtained conditions.

29. As in Claim 3, Maruhashi discloses the inclusion of information related to the material of the wound strip (Column 10, lines 35-37 and 43-46). The paper can be provided with type information in any one of the forms of the paper type indicia, paper type number, the type bar code, letters, image or the like, and the type information in a visible form can be read using an optical reader.

30. With regard to Claim 4, Maruhashi covers the inclusion of information related to the fabrication of the strip (Column 10, lines 35-37). The information may be in any one of the forms of the paper type indicia, paper type number, the type bar code, letters, image or the like.

31. In terms of Claim 5, Maruhashi calls for the inclusion of a packaging material identifier (Column 10, lines 27-28 and 35-37). The paper type indicia, paper type

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number, the type bar code, letters, image or the like can be printed on the material so that when read, the type of the paper can be discerned.

32. As for Claim 6, Maruhashi includes a product identifier (Column 10, lines 27-28 and 35-37). The information may be printed in any one of the forms of the paper type indicia, paper type number, the type bar code, letters, image or the like, so that it is readable by means of a suitable information reader.

33. In analyzing Claims 2-6, it is important to point out that the phrases “for packaging the product using said strip of packaging material”, “for identifying said strip of packaging material” and “for identifying said product to be packaged” merely recite the intended use of the identifier. Applicant's present claims do not structurally or materially define anything over the roll of paper material that is taught by Maruhashi.

34. As for Claim 7, the recording medium of Maruhashi includes a non-contact recording medium readable in a non-contact fashion (Column 10, Lines 25-28 and 58-60). The material in Maruhashi is such that the memory card can be accessed for reading according to a non-contact type of reading.

35. With regard to Claim 8, Maruhashi states the recording medium including a contact recording medium readable in a contact fashion (Column 10, Lines 25-28 and 58-60). The material in Maruhashi is such that the memory card can be accessed for reading according to a contact type of reading.

36. As for Claim 9, Maruhashi shows the wound strip of material having a hollow core and the recording medium being provided near the hollow core (Column 10, Lines

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28-37). The material is wound about a spool and the memory card/type information may be incorporated in the spool or printed on the spool.

37. In terms of Claim 10, Maruhashi teaches that the recording medium may be provided at an end of or near the end of the outermost periphery of the wound strip (Column 10, lines 30-34). The memory card may be attached to or incorporated in any one of the front end, the leader sheet, and the spool. The information may be printed on a back surface of the front end of the paper.

38. As in Claim 11, Maruhashi discloses that the recording medium may be provided on a sheet-like member that affixes an end of the outermost periphery of the wound strip (Column 10, lines 30-34). The memory card may be attached to or incorporated in any one of the front end or the leader sheet. The information may be printed on a back surface of the front end of the paper.

39. Overall, with respect to Claims 1-11, the recitation of such phrases as “a wound strip of packaging material for use in packaging a product” (from Claim 1) and “wherein said packaging related information includes ...” (from Claims 2-6) does not positively recite any definite structure over that which is taught by the Maruhashi patent.

Applicant has simply recited a condition for packing the product, which merely refers to the intended use of the recording medium. Furthermore, applicant has not positively recited a product but only a “material” that could potentially be used “in packaging a product” which defines nothing structurally distinct over that of the sheet or film as taught by Maruhashi.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Joy
Examiner
Art Unit 1774

04/07/2006



RENA DYE
SUPERVISORY PATENT EXAMINER

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